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Mailed: July 25, 2002
Paper No. 14
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re American Historical Publications, Inc.

Serial No. 75/809,901

Joseph J. Previto of Collard & Roe, P.C. for American
Historical Publications, Inc.

Ysa de Jesus, Trademark Examining Attorney, Law Office 101
(Jerry Price, Managing Attorney).

Before Hanak, Wendel and Rogers, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

American Historical Publications, Inc. has filed an
application to register the mark WHAT IF? for, as amended,
"publications, namely, books featuring historical themes."¹

¹ Serial No. 75/809,901, filed September 29, 1999, claiming a
first use date and a first use in commerce date of September 13,
1999.

Registration has been finally refused under Section 2(d) of the Trademark Act on the ground of likelihood of confusion with the mark WHAT IF..., which is registered for "publications, namely, comic books and comic magazines."²

The refusal has been appealed and applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

We make our determination of likelihood of confusion on the basis of those of the *du Pont*³ factors that are relevant in view of the evidence of record. Two key considerations in any analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods or services with which the marks are being used, or are intended to be used. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Looking first to the marks, we agree with the Examining Attorney that applicant's mark WHAT IF? and registrant's mark WHAT IF... are identical in sound and highly similar, if not virtually the same, in appearance

² Registration No. 1,868,234, issued December 20, 1994, Section 8 & 15 affidavits, accepted and acknowledged, respectively.

³ *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

and connotation. Although applicant argues that the question mark in its mark results in a distinctive appearance and one different from the ellipsis (or suspension points as described by the Examining Attorney) used by registrant, we do not think the variance in punctuation marks makes a significant difference in the commercial impressions created by the marks.

First of all, the marks contain the same words and are, as noted, pronounced the same. Second, the connotation of the expression WHAT IF is the same regardless of whether the words are followed by a question mark or an ellipsis, insofar as registrant's mark WHAT IF... implies that a question mark would be at the end if its question were completed. To put it in the words of the Examining Attorney, regardless of the punctuation used, both marks are "luring the reader into using their imaginations for a proposed setting conjured by the author." (Brief, p. 7).

Accordingly, the only distinction whatsoever in the two marks is the difference in appearance resulting from the use of a question mark in applicant's mark and the ellipsis in registrant's mark. While this difference would be apparent on a side-by-side comparison of the marks, this is not the test to be applied in determining likelihood of

confusion. Instead it is the similarity of the general overall commercial impressions created by the marks which is the determinative factor, because purchasers may come upon the marks at different points in time. This necessarily requires us to consider the fallibility of memory and the consequent lack of perfect recall. The proper emphasis is thus on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Spoons Restaurants Inc. v. Morrison, Inc.*, 23 USPQ2d 1735 (TTAB 1991); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Here we find the general overall commercial impressions created by the marks WHAT IF? and WHAT IF... to be virtually the same. If the difference in the forms of punctuation is noted at all, both forms simply reinforce the connotation of the words and leave the purchaser with the same overall impression, namely, the posing of a hypothetical situation.

Applicant's other argument is directed to the manner of use of the two marks. Applicant has made of record copies of the covers of two of registrant's comic books and points to these as evidence that the character illustrations are so overwhelming on the covers that the mark is hardly noticeable and makes little or no commercial

impression. Applicant contends that when compared with applicant's manner of use of its mark, as evidenced by the specimens, the differences in the marks are "outstanding, obvious and startling."

As pointed out by the Examining Attorney, registrant's mark is registered in typed drawing form. As such, the mark is not limited to use in any particular style and especially not to the manner in which it is presently being used in commerce. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Vornado, Inc. v. Breuer Elec. Mfg. Co.*, 390 F.2d 724, 156 USPQ 340 (CCPA 1968). The display of the registered mark in the present style is irrelevant since the display may be changed at any time according to the whim of the registrant. Simply because registrant presently uses its mark in a manner asserted to be "startlingly" different from that of applicant's current usage does not preclude registrant from later adopting a style similar to applicant, or from displaying its mark in a larger or more prominent display on its covers. No distinction between the marks can be drawn on the basis of the particular displays presently being used by applicant and registrant.

Thus, we turn to a comparison of the respective goods with which applicant and registrant are using these highly

similar marks. In making our analysis, we are guided by the general principle that the greater the degree of similarity in the marks, the lesser the degree of similarity that is required between the goods on which the marks are being used to support a likelihood of confusion. If the marks are almost the same, as is the case here, there need only be a viable relationship between the goods in order to support a holding of likelihood of confusion. See *In re Peebles Inc.*, 23 USPQ2d 1795 (TTAB 1992); *In re Concordia International Forwarding Corp.*, 222 USPQ 255 (TTAB 1983).

The Examining Attorney maintains that the goods are closely related; and that registrant has not narrowed the subject matter of its comic books or comic magazines to any particular subject matter and thus may feature historical themes such as those covered in applicant's books. The Examining Attorney points to copies of third-party registrations which she has made of record as evidence that owners of marks used to identify books may also use these marks to identify comic books or comic magazines.

Applicant, on the other hand, argues that applicant's books featuring historic themes and registrant's comic books are totally different from one another. Applicant insists that the goods are not used together, are not

considered to be in the same category or area of the publishing field, and are completely distinguishable by sight.

The issue of likelihood of confusion must be determined on the basis of the goods as identified in the application and in the cited registration. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed.Cir. 1987). It is not necessary that the goods of applicant and registrant be similar or even competitive to support a holding of likelihood of confusion. It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate from, or are associated with, the same source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993) and the cases cited therein.

Thus, the question here is not whether registrant's comic books and applicant's books featuring historical themes are similar or even competitive. There is no need for the publications to be used together or to be considered to be in the same category in the publishing

field.⁴ The question is whether a sufficient relationship exists between these publications that purchasers would be likely to believe that applicant's books and registrant's comic books originate from a single source, if similar marks are used thereon.

As identified in the registration, registrant's comic books are not limited with respect to subject matter and thus may feature a historical theme similar to applicant's. The only definite difference in the two types of publications lies in the manner of depiction of this subject matter. Furthermore, we find from the copies of third-party registrations which the Examining attorney has made of record clear evidence that the same source may produce publications in both the comic book and normal book formats on a single topic and publish the same under the same mark. For example, Registration No. 2,427,887 is for the mark ARE WE THERE YET? for "printed matter, namely, a series of comic books, picture books and fiction books in the field of comedy"; Registration No. 2,428,637 is for the mark STARSHIP TROOPERS for, inter alia, "books and comic books with science fiction themes"; Registration No.

⁴ Applicant's reliance upon the standards applied in the infringement case of *Lang v. Retirement Living Publishing Co., Inc.*, 949 F.2d. 576, 21 USPQ2d 1041 (2nd Cir. 1991) is misplaced. The issue here is that of registration and the relevant standards are different.

2,410,934 is for the mark UFO INVESTIGATOR for, inter alia, "comic books, comic magazines, a series of fiction and non-fiction books all featuring information on unidentified flying objects", and Registration No. 2,376,082 is for the mark POST MORTEM for "printed matter and materials, namely, a series of fiction books and comic books in the field of fantasy and adventure." While these registrations are admittedly not evidence of use of the marks for these goods in commerce, they are sufficient to suggest that the goods are of a type which may be produced by a single entity and be identified by the same mark. See *In re Albert Trostel & Sons Co.*, *supra*, *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467 (TTAB 1988), *aff'd* as not citable precedent 88-1444 (Fed. Cir. November 14, 1988). Accordingly, if similar marks are used on both types of publications, as is the case here, it may be presumed that purchasers will mistakenly believe that the publications emanate from the same source.

Although applicant argues that there is little resemblance between the two types of publications and a purchaser would be well aware of whether he is buying comic books or books relating to history, this does not preclude the likelihood of confusion if similar marks are used on the goods. The issue to be determined is not whether the

goods of applicant and registrant are likely to be confused, but rather whether there is a likelihood that purchasers will be misled into believing that the goods emanate from a common source. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). We find the evidence previously cited more than adequate to demonstrate that there is a clear likelihood for purchasers to mistakenly believe that the two types of publications come from the same source, particularly when such highly similar marks are used thereon.

Applicant further argues that the channels of trade for the two types of publications would be different, with the comic books and books relating to historic themes being sold in different types of retail outlets, for different purposes and to different purchasers. There are no restrictions, however, in either the application or the registration as to the channels of trade or class of purchasers and thus it must be assumed that the goods would travel in all the normal channels of trade for goods of this nature and to all the normal classes of purchasers. See *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992). Applicant has made no evidence of record to support its contention that the two types of publications would not be sold in the same retail

outlets. Instead, we consider it highly likely that there would be overlapping outlets for these publications, be they bookstores, variety or discount stores, or even on-line sources of various publications.

Nor do we have any reason to believe that persons interested in purchasing comic books would never purchase books with a historical theme. The audience for registrant's comic books is in no way limited by the registration and thus encompasses all ages and classes of purchasers, ranging from the adult comic book collector to the teenage consumer. The potential purchasers for applicant's books may similarly vary in age or purpose. Thus, for our analysis of likelihood of confusion, the products of both applicant and registrant must be assumed to travel in the same channels of trade and to be available to the same classes of purchasers.

Applicant also contends that applicant's books would only be purchased after careful selection, and would appeal to more sophisticated purchasers, who would likely be aware that the source of the books which they are purchasing is not the same as that of comic books. Despite the presumed sophistication of these purchasers in the field of books dealing with historical themes, this does not make them immune to source confusion, even though they may not be

confused as to the nature of the publications. Both types of books could still be mistakenly believed to originate from the same publisher. This is especially true when the marks are substantially identical in commercial impression, as is the case here, and a viable relationship has been shown to exist between the two types of publications. See *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999).

Finally, applicant raises the lack of evidence of any actual confusion, even though applicant has been using its mark for more than two years. We can give little weight to this fact, however, under the present circumstances. In the first place, registrant has not had the opportunity to be heard from on this point. See *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984). Second, in the absence of any evidence of the extent of applicant's use of its mark or the size of the market for its goods, the question arises as to whether there has been any real opportunity for confusion. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992). In any event, the issue is not actual confusion, but rather likelihood of confusion.

Accordingly, on the basis of the highly similar nature of the respective marks, the relationship that has been shown to exist between the publications of applicant and

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registrant and the common channels of trade, we find that confusion is likely.

Decision: The refusal to register under Section 2(d) is affirmed.